

REMARKS

Applicant thanks the Examiner for conducting a teleconference with his attorney on February 9, 2005. The teleconference was focused on the subject matter of claim 1, and a tentative agreement was reached regarding how that claim might be amended to be allowed by the Examiner. Additionally, it is Applicant's understanding that the section 112 rejections regarding the wheel biasing member and how it predisposes a cutting wheel to extend into a pipe slot were discussed with the Examiner and overcome. Particularly, the Examiner was concerned "how a wheel biasing member pre-disposing a cutting wheel extends into a pipe slot without a counter force," and it was pointed out that the claims do not actually claim such a structure. That is, rather than claiming a wheel biasing member that extends into a pipe slot, the claims claim a cutting wheel that extends into a pipe slot by being acted upon by the wheel biasing member. Indeed, the Examiner, in the detailed action at page 2, appreciated this relation when he stated that "[t]he Specifications teaches a plate spring 56 (which is the wheel biasing member) urging (forcing/biasing) the cutting wheel to extend into pipe slot." That is exactly what is claimed, and the 112 rejection should be overcome. Indeed, further amendments presented here should further support the removal of the section 112 rejections, and reconsideration is respectfully requested.

Applicant first addresses newly added claims 18 and 19 that were rejected in the final Office Action. These claims were added in light of the Examiner's indication that the subject matter of claims 8 and 11 would be allowable. Admittedly, the Examiner indicated that such subject matter would be allowable if incorporated into an independent claim along with all the other claims from which it depended. But in reviewing the prior art, it came to Applicant's attention that none of the prior art taught a retraction hook that operates as claimed. Thus, Applicant sought slightly broader protection. In Applicant's prior response, Applicant respectfully asked the Examiner to review the new claims, and the Examiner has now rejected those newly added claims as being anticipated by either Lazarevic (claim 18) or VanderPol (claim 19).

In Lazarevic, the Examiner turns to elements 57, 58 to satisfy the retraction hook element. However, elements 57, 58 do not "selectively engage" a shaft of the cutting wheel

“during rotation of said rotary head portion in a retracting direction.” This is the claim language of claim 18, and it is not met by Lazarevic. Elements 57, 58 of Lazarevic are always engaged with the shaft of the cutting wheel and thus cannot anticipate the claim.

Regarding VanderPol and claim 19, the Examiner has indicated that element 28 is a retraction plate and element 30 is a retraction rod, satisfying claim 19. VanderPol does not teach “a retraction plate extending from said plate spring member; and a retraction rod that engages said retraction plate during rotation of said rotary head portion in a retracting direction.” Indeed, VanderPol does not teach a plate spring member. The only spring in VanderPol is element 36, and this is not a plate spring, as claimed. The Examiner points to element 28 as a plate spring member, which he cannot do if he is to interpret “plate spring member” as it would be understood in the art and particularly in light of Applicant’s specification. Reconsideration is respectfully requested.

Regarding claims 18 and 19, Applicant notes that, when the Examiner indicated the allowability of claims 8 and 11, and asked that those claims be incorporated into a independent claim including all the subject matter of the intervening claims, none of the intervening claims had anything to do with the retraction hook, retraction plate, and retraction rod elements of claims 8 and 11. Thus, it is hard to see how the intervening claims had any impact on the allowable subject matter of claims 8 and 11. Thus, Applicant chose not to include every single limitation of every single intervening claim but rather sought the broadest claim to which he should be entitled.

Applicant now addresses claims 4 and 16, which were not discussed during the teleconference. Claims 4 and 16, as should be apparent from a reading of the specification, are directed toward the embodiment shown in the application at Figs. 5 and 6 and Figs. 9a-c. Referring to Figs. 9a-c, it should be clear that claims 4 and 16 are directed toward the special gearing system provided in the present application. The slot engaging gear of the claims would be element 276, having teeth that are keyed to the teeth of the housing gear 214. One rotation of slot engaging gear 276 results in one rotation of housing gear 214, and this is accomplished, despite the existence of pipe slot 238, due to the protrusion 340 on slot engaging gear 276 that

extends beyond the teeth 276 and engages pipe slot 238 once during each rotation of slot engaging gear 276 and housing gear 214.

Such claim structure is not shown anywhere in VanderPol or Lazarevic. Indeed, the Examiner points to gear 31 of Lazarevic as a slot-engaging gear, but that gear does not have a protrusion that extends beyond its teeth to engage the pipe slot once during each rotation. Additionally, gear 31 is so much smaller than the housing gear 19 that there is no way that one rotation of gear 31 can result in one rotation of the housing gear 19. Notably, although claim 16 has been rejected with VanderPol, the Examiner has made no attempt to actually apply VanderPol to anticipate the elements of claim 16. See page 6 of the detailed action. Regardless, a review of VanderPol will show that the claimed structure in claims 4 and 16 is not shown therein.

Finally, Applicant addresses claim 1 and the amendments made thereto. In the teleconference with the Examiner, Applicant's attorney discussed the major distinction between Applicant's invention and those of the prior art. It was pointed out that Applicant spring biases a cutting wheel to extend into the pipe slot of his pipe cutter, and it is the spring bias that actually forces the cutting wheel into the pipe to cut the pipe during use. VanderPol shows the exact opposite practice, wherein a spring is employed to remove the cutting wheel from the pipe slot. That spring force has to be overcome by gearing mechanisms to drive the cutting wheel into the pipe. Thus VanderPol teaches away from claim 1. See VanderPol at column 3, lines 25-50. Lazarevic employs cam slots 57, 58 and pins 39, 56 to urge the cutter 37 and the rollers 52 toward the tube 14 to be cut. See Lazarevic at column 4, lines 44-63 and column 5, lines 9-28. These cam slots and pins are completely distinct from the spring member currently claimed, and reconsideration is respectfully requested.

In light of the foregoing, the distinctions to be drawn between the present claimed invention and those pipe cutters of the prior art should be readily apparent, and reconsideration of all pending claims is respectfully requested. Because the presently claimed invention advances the art and provides pipe cutter structures that were heretofore unknown, a Notice of Allowance of all pending claims is earnestly solicited. Applicant again thanks the Examiner

for conducting the interview with his attorney, and, should the Examiner have any further questions or concerns, a follow-up teleconference would be greatly appreciated.

No new claims have been added and therefore no additional fees are believed due at this time. Nonetheless, in the event that a fee required for the filing of this document is missing or insufficient, the undersigned attorney hereby authorizes the Commissioner to charge payment of any fees associated with this communication or to credit any overpayment to Deposit Account No. 18-0987.

Respectfully submitted,



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